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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,733	03/16/2004	Kazuto Yamamoto	011350-328	1040
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EXAMINER				
WILLS, LAWRENCE E				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
09/01/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

### Office Action Summary

**Application No.**

10/800,733

**Applicant(s)**

YAMAMOTO ET AL.

**Examiner**

LAWRENCE E. WILLS

**Art Unit**

2625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38, 41, 42, 46, 49, 50, 54 and 58-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38, 41, 42, 46, 49, 50, 54 and 58-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed April 29, 2009 have been fully considered but they are not persuasive. Applicant states on page 3 lines 3-6:

"In paragraph 2 of the Office Action the Examiner argues that *Teraura* discloses a reading unit for reading image data from an electronic tag and said electronic tag stores image data printed on the electronically tagged printing paper. This assertion is respectfully traversed."

However, *Teraura*'279 teaches reading of RFID data in Step B5, Fig. 7 (for reading image data from an electronic tag) and storing and printing the read data in Steps B17 and B18 (electronic tag stores image data printed on the electronically tagged printing paper.).

Applicant argues on page 3, lines 20-24:

Claim 38 recites that the second reading unit reads out modifiable attribute information that corresponds to attribute information which constitutes an appearance of original image data of the image data on the electronically tagged printed matter from an electronic tag. The Examiner recognizes that such a feature is not disclosed in either the *Teraura* or *Yano* references.

*Yano*'194 teaches a reading unit (number 520, Fig. 8) for reading out modifiable attribute information (additional information, paragraph 0102-0110) among attribute information of said electronically tagged printed matter from said electronic tag (data from IC chip, paragraph 0106); a display unit (number 26, Fig. 4) for displaying the modifiable attribute information read out by said

second reading unit (Fig. 10/11); a modifying unit (number 510, Fig. 8 user interface) for modifying the modifiable attribute information read out by said second reading unit (user operation designating an output format, paragraph 104); and a printing unit (number 560, Fig. 8) for printing image data read by said reading unit, based on the attribute information modified by said modifying unit (§110, Fig. 9).

Applicant argues on page 4, lines 1-16:

Applicants respectfully disagree with the Examiner's assertion that *Watanabe* overcomes the deficiencies of *Teraura* and *Yano*. *Watanabe* discloses at paragraph [0133] that the information stored on the IC chip 3 may be area data and attribute data. An attribute of a text is defined in paragraph [0013] of *Watanabe* as, for example, a character, numeral, symbol, which are printed by a predetermined font and an attribute of a picture maybe a drawing and photograph. See also paragraph [0014] and Figs. 4 and 11 where text and picture are given as examples of attribute data. However, none of these are disclosed as being subject to modification. As described at paragraph [0012], a position and an area (area data with respect to each of the images displayed on the paper original are recorded in association with attributes. Thus, the area data only refers to a printing position of the contents data. There is no disclosure of a modifying unit for modifying the modifiable attribute information read out by the second reading unit nor any disclosure of reading out modifiable attribute information corresponding to attribute information which constitutes an appearance of original image data as in Applicants' independent claim 38.

However, the area data and the attribute data are modifiable as shown in paragraph 0140, image processing section 550 corrects a portion where the text/picture separation result is not coincident with the area data and the attribute data by using the area data and the attribute data. Both are modifiable by the image processing section.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 38, 41, 42, 46, 49, 50, 54, and 58 -61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (US Patent 6,827,279) in view of Yano (US Pub. No. 2004/0109194) and in further view of Watanabe et al. (US Publication No. 2004/0075867).

Regarding claims 38, 46, and 54 Teraura'279 teaches an image forming device (number 1, Fig. 5), comprising: a reading unit (number 15, Fig. 5) for reading image data from an electronic tag of an electronically tagged printed matter (Step B5, Fig. 7) wherein image data is printed (Step A5, Fig. 6) on an electronically tagged printing paper equipped with the electronic tag (Fig. 1) for storing electronic data in a certain part of the printing paper (Step A4, Fig. 6) and said electronic tag stores image data printed on said electronically tagged printing paper (B14 and B15, Fig. 8); and a second reading unit (number 16, Fig. 5).

Teraura'279 fails to teach a reading unit for reading out modifiable attribute information among attribute information of said electronically tagged printed matter from said electronic tag; a display unit for displaying the modifiable attribute information read out by said second reading unit; a modifying unit for modifying the modifiable attribute information read out by said second reading unit; and a printing

unit for printing image data read by said reading unit, based on the attribute information modified by said modifying unit.

Yano'194 teaches a reading unit (number 520, Fig. 8) for reading out modifiable attribute information (additional information, paragraph 0102-0110) among attribute information of said electronically tagged printed matter from said electronic tag (data from IC chip, paragraph 0106); a display unit (number 26, Fig. 4) for displaying the modifiable attribute information read out by said second reading unit (Fig. 10/11); a modifying unit (number 510, Fig. 8 user interface) for modifying the modifiable attribute information read out by said second reading unit (user operation designating an output format, paragraph 104); and a printing unit (number 560, Fig. 8) for printing image data read by said reading unit, based on the attribute information modified by said modifying unit (S110, Fig. 9).

The combination of Yano'194 and Teraura'279 fail to teach modifiable attribute information corresponding to attribute information which constitutes an appearance of original image data of the image data on the tag.

Watanabe'867 teaches modifiable attribute information corresponding to attribute information which constitutes an appearance of original image data of the image data on the tag (store area data and the attribute data, paragraph 0133).

Having a system of Teraura'279 reference and then given the well-established teaching of Yano'194 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the RFID read/write MFP system of Teraura'279 reference to include means for controlling additional information as taught by Yano'194 reference. The combination would have increased the flexibility of the MFP system, further, the control of additional information would

have yielded predictable results when applied to the MFP system. Further, having a system of Teraura'279 and Yano'194 reference and then given the well-established teaching of Watanabe'867 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electronic tag system of Teraura'279 and Yano'194 reference to include attribute information as taught by Yano'194 reference since the substitution of one known element for another would have been predictable.

Regarding claims 41 and 49 the combination of Teraura'279, Yano'194, and Watanabe'867 teach wherein said printing unit (Teraura'279, number 11, Fig. 5) prints image data on an electronically tagged printing paper equipped with an electronic tag for storing electronic data in a certain part of the printing paper (Teraura'279, Fig. 1), further comprising: a writing unit (Teraura'279, number 17, Fig. 5) for writing the image data printed by said printing unit on the electronic tag of the electronically tagged printing paper on which the image data is printed by said printing unit (Teraura'279, Step A4, Fig. 6).

Regarding claims 42, 50 and 58 the combination of Teraura'279, Yano'194, and Watanabe'867 teach wherein said electronic tag transmits or receives electronic data by means of wireless communications (Teraura'279, radio wave signals, column 4, lines 48-53).

Regarding claim 59, the combination of Teraura'279, Yano'194, and Watanabe'867 teach wherein said modifiable attribute information is a format of the image data on said electronically tagged printed matter from said electronic tag (Watanabe'867 contents data is read from the IC chip, a part of the image, which is to be printed, paragraph 0186).

Regarding claim 60 the combination of Teraura'279, Yano'194, and Watanabe'867 wherein said modifiable attribute information corresponds to at least one of image data's color, resolution, font size, font color, and font type (Watanabe'867 font image of text data, paragraph 0163).

Regarding claim 61 the combination of Teraura'279, Yano'194, and Watanabe'867 wherein said electronic tag stores electronic data having a header part storing said modifiable attribute information (Watanabe'867 attribute data, paragraph 0133) and an image data part storing the original image data (Watanabe'867 area data, paragraph 0133) and attribute data defined by said modifiable attribute information (Watanabe'867 Fig. 4 and Fig. 11).

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAWRENCE E. WILLS whose telephone number is (571)270-3145. The examiner can normally be reached on Monday-Friday 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/  
Supervisory Patent Examiner, Art Unit 2625

LEW  
August 24, 2009